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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/568,759 | 02/21/2006 | Yutaka Harano | AI 402NP | 6656 |
| 23995 7590 10/27/2010 RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005 | | | | |
| EXAMINER | | | | |
| MEHTA, HONG T | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,759

Applicant(s)

HARANO, YUTAKA

Examiner

HONG MEHTA

Art Unit

1789

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 12, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 10, 12, 13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's amendment and remarks filed on September 30, 2010. Amended claims 1, 3-5, 10, 12, 13 and 15 are under examination. Claims 2, 9, 11 and 14 are cancelled. Claims 6-8 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

((a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. **Claims 1, 4, 5, and 13 rejected under 35 U.S.C. 102 (a) as being anticipated by Harano et al. ("Evaluation of Metabolic Effectiveness of Exercise Habit Using Respiratory Analyses and a Newly Developed Cookie Test").**

3. **Regarding claim 1**, Harano et al. discloses a cookie food product (test food) comprising 75 grams of flour starch (carbohydrates) and 24 grams of fat (p. A260, column 1, second paragraph).

4. **Regarding claims 4, 5, and 13**, Harano et al. discloses the cookie food product is use in evaluation of metabolic effectiveness including blood measurement for hyperinsulinemia, glucose intolerance and insulin resistance (p. A260, column 1, second paragraph). Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Harano et al. discloses cookie food product with amounts of carbohydrates and fat as claimed, therefore the Harano's cookie food product is expected to perform the same function or intended use as cited in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 3, 10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harano et al. ("Evaluation of Metabolic Effectiveness of Exercise Habit Using Respiratory Analyses and a Newly Developed Cookie Test").**

8. Harano et al. discloses the cookie food product is use in evaluation of metabolic effectiveness including blood measurement for hyperinsulinemia, glucose intolerance and insulin resistance (p. A260, column 1, second paragraph). Harano et al. is silent regarding the cookie providing 460 to 600 kilocalories. However, it would have been obvious to one of ordinary skill in the art to optimize amounts of ingredients such as

carbohydrates and fat in the cookie formulation to obtain a desired caloric amount in the food for desired nutrition.

Response to Arguments

9. Applicant's arguments on pages 8-9, filed September 30, 2010, with respect to amounts range of carbohydrates and fat in food product have been fully considered and are persuasive. The 102(b) and 103(a) rejections of Palmason et al. has been withdrawn.

10. Applicant's declaration 37 C.F.R. § 1.131 submitted on September 30, 2010 has been fully considered but is not persuasive to overcome the 102 (a) rejection with prior art Hanaro et al. ("Evaluation of Metabolic Effectiveness of Exercise Habit Using Respiratory Analyses with a Newly Developed Cookie Test"). Applicant has stated that the information of the abstract was communicated at a presentation of the prior art Abstract at International Diabetics Federation on August 7, 2003 which is considered to qualify the abstract under 102(a) as known by others, as public knowledge, see MPEP 2133.03 (a). Note that public knowledge may provide grounds for rejection under 35 U.S.C. 102(a) See MPEP § 2132. It is noted that applicant supplied the Harano abstract on the IDS submitted December 7, 2007 and noted the date as August 7, 2003.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG MEHTA whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Htm

/Jennifer C McNeil/
Supervisory Patent Examiner, Art Unit 1784